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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,597	07/28/2003	Alton W. Hezeltine	884.413US2	4627
21186	7590	10/05/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			CHUKWURAH, NATHANIEL C	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/628,597	HEZELTINE, ALTON W.	
	Examiner	Art Unit	
	Nathaniel C. Chukwurah	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/31/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 9, 20 and 29 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 11 and 21, respectively, of prior U.S. Patent No. 6,622,802. This is a double patenting rejection.

Claim 17 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 16 of prior U.S. Patent No. 6,622,802. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 10 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, respectively, of U.S. Patent No. 6,622,802. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ merely in the scope of the subject matter claimed; i.e. claims 1-8, 10 and 11 are substantially included in the claims 1-10, respectively, of the US Patent No. 6,622,802, but omit the feature non-critical to patentability, for example, a vacuum element couple to the chamber to retract the piston. They are not patentably distinct from each other because the claims of the present application are made broader than the specifics of the claims of the Patent, which anticipate broader claims of the application.

Claims 12-16, 18, 19, 21 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-15 and 17-20, respectively, of U.S. Patent No. 6,622,802. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ merely in the scope of the subject matter claimed; i.e. claims 12-16, 20 and 21 are substantially included in the claims 11-15, 19 and 20, respectively, of the US Patent No. 6,622,802, but omit the feature non-critical to patentability, for example, a vacuum element couple to the chamber to retract the piston. They are not patentably distinct from each other because the claims of the present application are made broader than the specifics of the claims of the Patent, which anticipate broader claims of the application.

Claims 23-28 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-27, respectively, of U.S. Patent No. 6,622,802. Although the conflicting claims are not identical, they are not patentably distinct

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from each other because the claims differ merely in the scope of the subject matter claimed; i.e. claims 23-25 and 27-30 are substantially included in the claims 21-23 and 25-27 of the US Patent No. 6,622,802, but omit the feature non-critical to patentability, for example, a vacuum element couple to the chamber to retract the piston. They are not patentably distinct from each other because the claims of the present application are made broader than the specifics of the claims of the Patent, which anticipate broader claims of the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Hezeltine (US 6,622,802).

With regard to claim 1, Hezeltine discloses a tool comprising: a tool (10) comprising: a body (140) having a chamber (148); a piston (126) within the chamber; a nose (190) having a channel (193); a pin (162) within the channel and physically independent of the piston (126); a propulsion element (air) coupled to the body to propel the piston (126) against the pin (162); and an actuation element (101) coupled to the propulsion element to actuate the propulsion element.

With regard to claim 2, the channel (193) is dimensioned to retain a fastener until the propulsion element is actuated.

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With regard to claim 3, the piston (126) has more mass than the pin (162).

With regard to claim 4, the piston comprises at least one resilient bumper (122).

With regard to claim 5, the tip adapter (185) within the channel (198) has an interior bore (188) within which the pin (162) is movable.

With regard to claim 6, the tool comprises a vacuum element (74) couple to a vacuum generator (70), wherein the nose (190) comprises a passage (226) to receive vacuum from the vacuum element (74), and wherein the tip adapter (185) comprises a cylindrical wall having a hole (186) to communicate with the passage to receive vacuum.

With regard to claim 7, the tip adapter comprises an additional actuation element (185) coupled to the propulsion element (air) wherein the propulsion element is to be actuated only if both the actuation element (101) and the additional actuation element (185) are moved.

With regard to claim 8, the actuation element (101) and the additional actuation element (185) each comprise a blocking element (110, 136) to block a pilot air vent (112).

With regard to claim 9, the tool comprises a vacuum element (86) coupled to the chamber (148) to retract the piston (126) when vacuum is applied to the vacuum element.

With regard to claim 10, the actuation element (101) comprises a depressible member (102) to move within the channel (198).

With regard to claim 11, the propulsion element (see Fig. 1) comprises a supply hose connection and a pilot hose connection to couple to a supply hose (86) and to a pilot hose (84), respectively, wherein the supply hose connection is to provide vacuum when air within the pilot hose connection is greater than a predetermined pressure, and wherein the supply hose

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connection is to provide air pressure when air within the pilot hose connection has less than the predetermined pressure.

With regard to claim 12, Hezeltine discloses a tool comprising:

a body (140) having a chamber (148)

a piston (126) within the chamber;

a nose (190) coupled to the body (140) and having a channel (193);

a pin (162) within the channel and physically independent of the piston (126);

an air delivery infrastructure (see Fig. 1) to propel the piston (126) against the pin (162);

and an actuation element (101) coupled to the air delivery infrastructure (see Fig. 1) to actuate the air delivery infrastructure.

With regard to claim 13, the channel (193) is dimensioned to retain a fastener until the air delivery infrastructure is actuated.

With regard to claim 14, the piston (126) has more mass than the pin (162).

With regard to claim 15, the piston (126) comprises at least one resilient bumper (122).

With regard to claim 16, the tool further comprises a tip adapter (185) within the channel (193) and having an interior bore (222) within which the pin (162) is movable.

With regard to claim 17, the tool further comprises a vacuum element, (74) wherein the nose (190) comprises a passage (226) coupled to the vacuum element (74) to receive vacuum, and wherein the tip adapter (185) comprises a cylindrical wall having a hole (186) to communicate with the passage (226) to receive vacuum.

With regard to claim 18, the tip adapter comprises an additional actuation element (185) coupled to the air delivery infrastructure (see Fig. 1), wherein the air delivery infrastructure is

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actuated only if both the actuation element (101) and the additional actuation element (185) are moved.

With regard to claim 19, the tool further comprises a pilot air supply(84) to first and second pilot air vents (112, 180), and wherein the actuation element (101) and the additional actuation element (185) each comprise a blocking element (110, 136) to block the first and second pilot air vents, respectively.

With regard to claim 20, the tool further comprises a vacuum element (86) coupled to the chamber (148) to retract the piston (126) when vacuum is applied to the vacuum element.

With regard to claim 21, the actuation element (101) comprises a depressible member (102).

With regard to claim 22, the air delivery infrastructure (see Fig. 1) comprises a supply hose connection and a pilot hose connection to couple to a supply hose (86) and to a pilot hose (84), respectively, wherein the supply hose connection is to provide vacuum when air within the pilot hose connection has greater than a predetermined pressure, and wherein the supply hose (86) connection is to provide air pressure when air within the pilot hose (84) connection has less than the predetermined pressure.

With regard to claim 23, Hezeltine discloses a fastener installation tool comprising: a body (140) having a cylindrical chamber (148); a primary hammer (126) movable within the chamber; a nose (190) coupled to the body (140) and having a channel (193) that is dimensioned to receive a fastener; a secondary hammer (163), physically independent of the primary hammer, having a pin (162) movable within the channel; an air delivery infrastructure (see Fig. 1) to propel the primary hammer (126) against the secondary hammer (163), to cause the pin (162) to

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strike the fastener; and an actuation element (101) coupled to the air delivery infrastructure to actuate the air delivery infrastructure.

With regard to claim 24, the primary hammer (126) has more mass than the secondary hammer (163).

With regard to claim 25, the tool further comprises a tip adapter (185) within the channel and having an interior bore (188) within which the pin (162) is movable.

With regard to claim 26, the tool further comprises a vacuum element (74), wherein the nose (190) comprises a passage (193) coupled to the vacuum element (74) to receive vacuum, and wherein the tip adapter (185) comprises a cylindrical wall having a hole (186) to communicate with the passage to receive vacuum.

With regard to claim 27, the tip adapter (185) comprises an additional actuation element (185) coupled to the air delivery infrastructure (see Fig. 1), wherein the air delivery infrastructure is actuated only if both the actuation element (101) and the additional actuation element (185) are moved.

With regard to claim 28, the tool further comprises a pilot air supply to first and second pilot air vents (112, 180), and wherein the actuation element (101) and the additional actuation element (185) each comprise a blocking element (110, 136) to block the first and second pilot air vents (112, 180), respectively.

With regard to claim 29, the tool further comprises a vacuum element (86) coupled to the chamber to retract the primary hammer (126) when vacuum is applied to the vacuum element.

With regard to claim 30, the air delivery infrastructure (see Fig. 1) comprises a supply hose connection and a pilot hose connection to couple to a supply hose (86) and to a pilot hose

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(840, respectively, connection has greater than a predetermined pressure, and wherein the supply hose connection is to provide air pressure when air within the pilot hose connection has less than the predetermined pressure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 12-16, 21 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 5,437,339) in view of Maier et al. (US 4,213,301).

Tanaka discloses a tool comprising: a body (1) having chamber, a piston (2) within the chamber, a nose (4) having a channel, a pin (3) within the channel, a propulsion element (27) to propel the piston, an actuation element (31) to actuate the propulsion element. The channel is dimensioned to retain a fastener until the propulsion element is actuated as evidenced in Figure 2. The piston (2) has more mass than the pin as shown in Figure 1. Tanaka further discloses at least one resilient bumper (5), a depressible actuation element (31), a primary hammer (7), a secondary hammer (2) having a pin (3) and the primary hammer has more mass than the secondary hammer as shown in Figure 1.

Tanaka lacks a pin physically independent of the piston. However, Maier et al. discloses similar tool including a pin (5) within a channel and physically independent of the piston (13).

In view of the teachings of Maier et al., it would have been obvious to one skilled in the art to provide the tool of Tanaka with a pin physically independent of the piston in order to move

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more effectively within the channel to strike workpiece. Although Tanaka does not disclose a tip adapter, tip adapter is well known in fastener driving tool to accommodate nails of different dimension and would have been obvious to one skilled in the art to provide the tool of Tanaka with a tip adapter to more effectively accommodate nails of different dimension.

Claims 11, 22 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka in view of Maier et al. as applied to claims 1, 12 and 23 and further in view of Lindsay (US 6,095,256).

Modified Tanaka lacks a supply hose connection and a pilot hose connection to couple to a supply hose and a pilot hose, respectively.

However, Lindsay teaches a supply hose connection (116) and a pilot hose connection (114) to couple to a supply hose and a pilot hose, providing vacuum and air pressure in the supply hose and pilot hose, respectively, in order not to depend on a spring for the piston's return or impact stroke (col. 2, lines 58-60).

Response to Arguments

Applicant's arguments filed 8/31/2005 have been fully considered but they are not persuasive.

With respect to claim 1 and 12, applicant argues that neither Tanaka nor Maier discloses a propulsion element or air delivery infrastructure to propel the piston pin.

The Examiner disagrees with applicant because Tanaka discloses an air delivery infrastructure as described, for example, "The compressed air supplied into the cylinder assembly drives impulsion piston (2) downwardly so that the driver (3) coupled to the lower end of the impulsion piston (2) drives a nail from the nose member (3) into a wooden plate" (col. 5,

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lines 38-43). Further, Maier discloses an air delivery infrastructure as described in column 6, lines 37-68; column 7, lines 1-45 which propels the primary hammer (13c) and against the secondary hammer (5).

With respect claim 23, applicant argues that asserted combination of Tanaka in view of Maier and Lindsay fails to teach or suggest all of the claim limitation present in independent claims 1, 12 and 23.

The Examiner disagrees with applicant because Tanaka and Maier disclose an air delivery infrastructure as described above; and Lindsay was used to teach a supply hose connection (116) and a pilot hose connection (114) to couple to a supply hose and a pilot hose, providing vacuum and air pressure in the supply hose and pilot hose, respectively which meet claim limitation.

Conclusion

Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathaniel C. Chukwurah whose telephone number is (571) 272-4457. The examiner can normally be reached on M-F 6:00AM-2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NC

Sept. 23, 2005


LOUIS K. HUYNH
PRIMARY EXAMINER